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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,747	02/05/2004	Juliet F. Knight	2003-0660.02	5719
21972 7590 02/02/2007 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			EXAMINER ZHOU, TING	
			ART UNIT	PAPER NUMBER
			2173	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/02/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/772,747

Applicant(s)

KNIGHT ET AL.

Examiner

Ting Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/05/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 are pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 23-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the preamble of independent claim 23 recites a device, the remainder of the claim does not support the preamble. The claimed features and elements of independent claim 23 do not include hardware components or features that are necessarily implemented in hardware. The “device” appears directed to software, per se, lacking any hardware to enable any functionality to be realized (the body of the claim recites an application and a graphical user interface, both of which are merely software programs). Therefore, the claimed features of claim 23 is actually a software, or at best, directed to an arrangement of software, and software claimed by itself, without being executed or implemented on a computer medium, is intangible. Claim 24 is dependent upon claim 23 and is rejected for similar reasons.

3. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

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anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 and 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the acquisition of data" in line 6. There is insufficient antecedent basis for this limitation in the claim. Claims 2-8 depend upon claim 1 and are rejected for similar reasons.

Claim 17 recites the limitations "the request" and "the occurrence of an action" in lines 4 and 9-10, respectively. There is insufficient antecedent basis for this limitation in the claim. Claims 18-22 depend upon claim 17 and are rejected for similar reasons.

Claim 21 recites the limitation "the time-to-live variable" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "the screen" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 8-9, 11-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden U.S. Patent 6,718,339 and Mor et al. U.S. Publication 2004/0263084 (hereinafter "Mor").

Referring to claim 1, Eden teaches a method comprising creating a profile that is associated with at least one action of the device (creating profiles for multifunction devices such as printers) (Eden: column 2, lines 1-20 and column 3, lines 36-39).

Although Eden teaches a graphical user interface (Eden: column 4, lines 14-23), Eden fails to explicitly teach generating an icon for display on the graphical user interface upon a request for the acquisition of data from the host and associating the profile with the icon. Mor teaches the storing of profiles (Mor: page 2, paragraph 0016) similar to that of Eden. In addition, Mor further teaches generating an icon for display on the graphical user interface upon a request for the acquisition of data from the host and associating the profile with the icon (the communication device can receive information from external sources and display information in response to the communication from the external source; for example, icons associated with profiles are displayed on the display screen of the user interface) (Mor: page 2, paragraph 0016). It would have been obvious to one of ordinary skill in the art, having the teachings of Eden and Mor before him at the time the invention was made, to modify the graphical user interface for creating a profile

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associated with an action of a device of Eden to include the use of icons to represent profiles taught by Mor. One would have been motivated to make such a combination in order to efficiently represent large amounts of information, thereby saving screen space, especially on devices with a small display screen, and avoiding cluttering of information.

Referring to claim 2, Eden, as modified, teach deleting the icon from the device upon the occurrence of an action (deletion of profiles, and therefore, the icons representing the profiles from the device upon occurrence of an action such as the expiration of a time-to-live (TTL) variable) (Eden: column 2, lines 1-31 and column 4, lines 45-50; Mor: page 2, paragraph 0016).

Referring to claim 3, Eden, as modified, teach deleting the profile from the device upon the occurrence of an action (deleting profiles upon occurrence of an action such as the expiration of a time-to-live (TTL) variable) (Eden: column 2, lines 1-31 and column 4, lines 45-50).

Referring to claim 4, Eden, as modified, teach wherein the action is the acquisition of the requested data (the profile is deleted upon the acquisition of the requested data, i.e. when the profile and information in the profile has been used) (Eden: column 4, lines 51-56).

Referring to claim 5, Eden, as modified, teach assigning a time-to-live variable to the profile (assigning a TTL variable to a profile so that the profile can be deleted when the TTL variable expires) (Eden: page 2, lines 12-31 and column 4, lines 45-50).

Referring to claim 6, Eden, as modified, teach wherein the action is the expiration of a time-to-live variable (assigning a TTL variable to a profile so that the profile can be

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deleted when the TTL variable expires) (Eden: page 2, lines 12-31 and column 4, lines 45-50).

Referring to claim 8, Eden, as modified, teach calling a tool that creates a customized configuration of the graphical user interface (customizing the GUI according to users, i.e. the GUI displays icons associated with particular users) (Mor: page 2, paragraph 0016).

Referring to claim 9, Eden, as modified, teach a network comprising at least one computer including an application for creating temporary profiles (a network connected computer terminal that creates temporary profiles) (Eden: column 2, lines 1-31 and column 4, lines 26-34); and at least one multifunction imaging device capable of communicating with the computer (MFP device such as the printer) (column 3, lines 31-60 and further shown in Figure 1), the imaging device having a store that is capable of storing the temporary profile (the device has a device store for storing the created temporary profiles) (Eden: column 3, lines 31-35 and Figure 1). However, although Eden teaches a graphical user interface (Eden: column 4, lines 14-23), Eden fails to explicitly teach creating an icon to be associated with the profile, having a graphical user interface adapted to display the icon, create the icon based upon information received from a user, and place the icon on the graphical user interface. Mor teaches the storing of profiles (Mor: page 2, paragraph 0016) similar to that of Eden. In addition, Mor further teaches creating an icon to be associated with the profile (Mor: page 2, paragraph 0016), having a graphical user interface adapted to display the icon, create the icon based upon information received from a user, and place the icon on the graphical user interface (the communication device can receive information such as user profiles from external

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sources and display an icon associated with the profiles on the display screen) (Mor: page 2, paragraph 0016). It would have been obvious to one of ordinary skill in the art, having the teachings of Eden and Mor before him at the time the invention was made, to modify the graphical user interface for creating a profile associated with an action of a device of Eden to include the use of icons to represent profiles taught by Mor. One would have been motivated to make such a combination in order to efficiently represent large amounts of information, thereby saving screen space, especially on devices with a small display screen, and avoiding cluttering of information.

Referring to claim 11, Eden, as modified, teach wherein the store of the imaging device stores a plurality of profiles in a profile list accessible to the user (the device store 104 shown in Figure 1 stores profiles that can be selected by the user, the profiles being stored in a list) (Eden: column 1, lines 31-40 and column 4, lines 14-40), and wherein the profiles are associated with various functions of the multifunction imaging device (the profiles include parameters relating to printing, scanning, faxing, etc. of the MFP device) (Eden: column 3, lines 48-51).

Referring to claim 12, Eden, as modified, teach wherein the functions of the multifunction imaging device include scanning, printing and faxing (the MFP can print, scan and fax) (Eden: column 3, lines 48-51). Although Eden, as modified, fails to explicitly teach that the functions of the multifunction imaging device include copying, it is notoriously well known that multifunction imaging devices can perform the copying function. The examiner takes official notice of this teaching. It would have been obvious to one of ordinary skill in the art to combine the use of the multifunction imaging device

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capable of printing, scanning and faxing, with a multifunction imaging device capable of copying.

Referring to claim 13, Eden, as modified, teach wherein the icon is customized to the user (the icons are customize to, i.e. associated with individual users) (Mor: page 2, paragraph 0016).

Referring to claim 14, Eden, as modified, teach wherein the icon is placed on the graphical user interface upon a data acquisition request (the communication device can receive information from external sources and display information in response to acquiring data from the external source; for example, icons associated with profiles are displayed on the display screen of the user interface) (Mor: page 2, paragraph 0016), and wherein the icon is removed from the graphical user interface upon the acquisition of the requested data action (deletion of profiles, and therefore, the icons representing the profiles from the device upon the acquisition of the requested data, i.e. when the profile and information in the profile has been used) (Eden: column 2, lines 1-31 and column 4, lines 45-56).

Referring to claim 15, Eden, as modified, teach wherein the profile is assigned a time-to-live variable, and wherein the icon is removed from the graphical user interface upon the expiration of the time-to-live variable (assigning a TTL variable to a profile so that the profile can be deleted when the TTL variable expires) (Eden: page 2, lines 12-31 and column 4, lines 45-50).

Referring to claim 16, Eden, as modified, teach wherein the computer causes the application to remove the icon after an action has occurred (deleting profiles upon

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occurrence of an action such as the expiration of a time-to-live (TTL) variable) (Eden: column 2, lines 1-31 and column 4, lines 45-50).

Referring to claim 17, Eden, as modified, teach a method comprising creating a temporary profile in the imaging device upon the request for the acquisition of data from the imaging device by a host (a network connected computer terminal, i.e. the host initiates the creation of temporary profiles, i.e. limited lifetime profiles for the connected device) (Eden: column 2, lines 1-37, column 3, lines 31-60 and column 4, lines 14-40 and further shown in Figure 1); deleting the profile from the graphical user interface upon the occurrence of an action (deleting profiles upon occurrence of an action such as the expiration of a time-to-live (TTL) variable) (Eden: column 2, lines 1-31 and column 4, lines 45-50). However, although Eden teaches a graphical user interface (Eden: column 4, lines 14-23), Eden fails to explicitly teach creating a customized icon associated with the temporary profile and displaying the customized icon on the graphical user interface to create a customized view on the graphical user interface. Mor teaches profiles (Mor: page 2, paragraph 0016) similar to that of Eden. In addition, Mor further teaches creating a customized icon associated with the profile (icons associated with individual user profiles are displayed) (Mor: page 2, paragraph 0016) and displaying the customized icon on the graphical user interface to create a customized view on the graphical user interface (customizing the GUI according to users, i.e. the GUI displays icons associated with particular users) (Mor: page 2, paragraph 0016). It would have been obvious to one of ordinary skill in the art, having the teachings of Eden and Mor before him at the time the invention was made, to modify the graphical user interface for creating a profile associated with an action of a device of Eden to include the use of icons to represent

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profiles taught by Mor. One would have been motivated to make such a combination in order to efficiently represent large amounts of information, thereby saving screen space, especially on devices with a small display screen, and avoiding cluttering of information.

Referring to claim 18, Eden, as modified, teach displaying a screen having at least one icon associated with a profile stored in the imaging device and related to a specific operation of the imaging device (Eden teaches profiles stored in the store of the MFP device include parameters relating to operations such as printing, scanning and faxing. of the MFP device; Mor teaches associating icons with profiles) (Eden: column 3, lines 48-51; Mor: page 2, paragraph 0016).

Referring to claim 19, Eden, as modified, teach wherein the action is the acquisition of the requested data (the profile is deleted upon the acquisition of the requested data, i.e. when the profile and information in the profile has been used) (Eden: column 4, lines 51-56).

Referring to claim 20, Eden, as modified, teach assigning a time-to-live variable (assigning a TTL variable to a profile so that the profile can be deleted when the TTL variable expires) (Eden: page 2, lines 12-31 and column 4, lines 45-50).

Referring to claim 21, Eden, as modified, teach wherein the action is the expiration of the time-to-live variable (assigning a TTL variable to a profile so that the profile can be deleted when the TTL variable expires) (Eden: page 2, lines 12-31 and column 4, lines 45-50).

Referring to claim 23, Eden, as modified, teach a multifunction imaging device comprising an application for creating a temporary profile (application 102 shown in Figure 1 creates temporary profiles) (Eden: column 2, lines 1-39 and column 3, lines 31-

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35); a graphical user interface (Eden: column 4, lines 14-39), wherein the application creates the profile in response to information received from a user (creating profiles according to user input on the GUI, i.e. selecting profile type and parameters) (Eden: column 4, lines 14-39). However, Eden fails to explicitly teach displaying an icon that is associated with the profile on a graphical user interface. Mor teaches profiles (Mor: page 2, paragraph 0016) similar to that of Eden. In addition, Mor further teaches displaying an icon that is associated with the profile on a graphical user interface (icons associated with individual user profiles are displayed on the GUI) (Mor: page 2, paragraph 0016). It would have been obvious to one of ordinary skill in the art, having the teachings of Eden and Mor before him at the time the invention was made, to modify the graphical user interface for creating a profile associated with an action of a device of Eden to include the use of icons to represent profiles taught by Mor. One would have been motivated to make such a combination in order to efficiently represent large amounts of information, thereby saving screen space, especially on devices with a small display screen, and avoiding cluttering of information.

Referring to claim 24, Eden, as modified, teach wherein the application removes the icon after an action has occurred (the profile, and therefore the icon associated with the profile, is deleted after an action has occurred, such as the expiration of the TTL variable) (Eden: column 4, line 45-50).

6. Claims 7, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden U.S. Patent 6,718,339 and Mor et al. U.S. Publication 2004/0263084

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(hereinafter “Mor”) as applied to claims 1, 9 and 17 above, and further in view of Shahine et al. U.S. Patent 6,624,831 (hereinafter “Shahine”).

Referring to claims 7, 10, and 22, Eden and Mor teach all of the limitations as applied to claims 1, 9 and 17 above. However, although Eden and Mor teach deleting profiles from the profile store in order to conserve space in the profile store (Eden: column 1, line 66-column 2, line 5), Eden and Mor fail to explicitly teach polling the graphical user interface to determine if there is enough space on the graphical user interface to add the icon. Shahine teaches a graphical user interface that displays and removes icons (Shahine: column 3, lines 35-46) similar to that of Eden and Mor. In addition, Shahine further teaches polling the graphical user interface to determine if there is enough space on the graphical user interface to add the icon (icons are added based on the determined amount of space available on the display for displaying icons) (Shahine: column 3, lines 35-46, column 4, line 59-61 and column 15, lines 44-51). It would have been obvious to one of ordinary skill in the art, having the teachings of Eden, Mor and Shahine before him at the time the invention was made, to modify the graphical user interface for displaying icons associated with profiles on the graphical user interface of Eden and Mor, to include the display of icons based on the available space on the graphical user interface, as taught by Shahine. One would have been motivated to make such a combination in order to create a dynamically adjustable graphical user interface that optimizes the number of icons being displayed in view of the amount of space available for displaying icons.

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7. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar methods of configuring the display of multifunction imaging devices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

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